

REMARKS

Claims 12 to 21 are currently pending in the present application.

In view of this response, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicants thank the Examiner for acknowledging the claim for foreign priority and for indicating that all certified copies of the priority documents have been received.

With respect to paragraph two (2) of the Office Action, claims 12 to 21 were rejected under 35 U.S.C. § 102(b) as anticipated by European Patent No. EP 1010867 ("Cardelli et al.").

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the prior Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied art." (*See* M.P.E.P. § 2112; emphasis in original; and *see Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

Claim 12 relates to a method for regulating a d.c. converter for at least two electromagnetic valves of an internal combustion engine, the method including supplying each of the at least two electromagnetic valves with a current that is generated by the d.c. converter, and includes the feature of *determining when a total current supplied to the at least two electromagnetic valves constitutes a high load for the d.c. converter, and if a high load is determined, adapting the d.c. converter for processing of the high load.*

In contrast, the Cardelli reference does not identically disclose (or even suggest) all of the features of claim 12. The Cardelli reference merely refers to a voltage-regulator circuit “for recovering the energy stored in the valve-actuating coils.” (Cardelli, ¶ 1). The Cardelli reference does not disclose the feature of determining when a total current supplied constitutes a high load for the d.c. converter, as provided for in the context of claim 12. The Office Action asserts that paragraph 23 of Cardelli indicates this feature (Office Action, p. 2), but Cardelli merely refers to driving the voltage-regulator circuit as a voltage-reducer if the capacitor is over-charged. (Cardelli, ¶ 23). Thus, Cardelli never discloses the feature of determining when a total current supplied constitutes a high load for the d.c. converter since it only refers to determining when a capacitor is over-charged. It is respectfully submitted that the state of charge of a capacitor is not necessarily linked to the load state for a d.c. converter. Since Cardelli never discloses the feature of determining when a total current supplied constitutes a high load for the d.c. converter, it does not disclose the feature of adapting the d.c. converter for processing of the high load if a high load is determined, as provided for in the context of claim 12. Therefore, Cardelli does not identically disclose (or even suggest) all of the features of claim 12.

Accordingly, it is respectfully submitted that claim 12 is allowable, as are its dependent claims 13 to 19.

Claims 20 and 21 include features similar to those of claim 12. Accordingly, it is respectfully submitted that claims 20 and 21 are allowable for essentially the same reasons as claim 12.

Withdrawal of the rejections of these claims is therefore respectfully requested.

In sum, claims 12 to 21 are allowable.

Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn, since all issues raised have been addressed and obviated. An early and favorable action on the merits is therefore respectfully requested.

Respectfully submitted,

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